



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/972,743	10/05/2001	John A Flygare	018781-001823US	5345

20350 7590 03/11/2003

TOWNSEND AND TOWNSEND AND CREW, LLP
TWO EMBARCADERO CENTER
EIGHTH FLOOR
SAN FRANCISCO, CA 94111-3834

EXAMINER

TRUONG, TAMTHOM NGO

ART UNIT,	PAPER NUMBER,
-----------	---------------

1624

DATE MAILED: 03/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/972,743

Applicant(s)

FLYGARE ET AL.

Examiner

Tamthom N. Truong

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-94 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-94 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ 6) ☐ Other: ____.

Art Unit: 1624

DETAILED ACTION

This is a continuation of application 09/ 633,740. Claims 1-94 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 9-11, 36-40, 47, 66-68, 89-92, and 94 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The following reasons apply:

- a. Claims 9 and 10 lack antecedent basis because they recite R^2 as a "phenyl substituted...with a divalent moiety that forms a...ring...", which suggests a bicyclic system that is not recited in claim 3.
- b. Claim 11 is rejected as being dependent on claim 10.
- c. Claims 36-40 lack antecedent basis because they recite compounds having R^1 and R^2 forming a ring with the nitrogen of NR^1R^2 , which is not recited in claim 2. Note, claim 2 appears to suggest R^2 as a ring by itself, but does not suggest R^1 and R^2 forming a ring. Furthermore, claim 1 does not recite R^1 and R^2 to form a bicyclic system as recited in claims 37-40.
- d. Claim 47 lacks antecedent basis because it recites species having a bicyclic system that are not recited in claim 46.

NO

Art Unit: 1624

e. Claims 66-68 lack antecedent basis because they recite R^2 as a bicyclic system which is not recited in claim 62.

NO f. Claims 90-92 lack antecedent basis because they recite R^1 and R^2 forming a bicyclic system, which is not recited in claim 89. Note, claim 89 recites that R^1 and R^2 forming a "5- or 6-membered heterocyclic ring", which suggests a monocyclic system.

g. Claim 94 is unclear whether it claims a method, a compound or a composition. Another word, the intended scope of claim 94 is unclear.

Double Patenting

The **nonstatutory** double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 1-5, 8, 12-16, 18, 19, 27, 30-34, 41, 43-46, 48, 49, 54-65, 69-73, 76, 79, 80, 83, 84, 87 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 5-10, 21, 24, 26, 28, 30-34, 36, 40-55, 58, and 63 of U.S. Patent No. 5,880,151. Although the conflicting claims are not identical, they are not patentably distinct

Art Unit: 1624

from each other because the compositions, methods and compounds claimed herein embrace those in US'151.

3. Claims 1-3, 9, 11, 36, and 37 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4, and 6-9 of U.S. Patent No. 6,121,304. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions and compounds claimed herein embrace those in US'304.

4. Claims 1, 30, 31, 43, 44, 54-61 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3-14 of U.S. Patent No. 6,316,484. Although the conflicting claims are not identical, they are not patentably distinct from each other because the compositions and compounds claimed herein embrace those in US'484. Note, the proviso in claim 61 has not adequately excluded the compounds claimed in US'484.

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A **statutory** type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Art Unit: 1624

5. Claims ~~6, 7, 17, 20-26, 28, 29, 35, 42, 50-53, 74, 75, 77, 78, 81, 82, 85, 86, 88, and 93~~ are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3, 4, 11, 14-20, 22, 23, 27, 29, 35, 37-39, 56, 57, 59-62, and 64-67 of prior U.S. Patent No. 5,880,151. This is a double patenting rejection.

6. Claims ~~38, 68, and 91~~ are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3, 5, and 10 of prior U.S. Patent No. 6,121,304. This is a double patenting rejection.

7. Claim ~~31~~ is rejected under 35 U.S.C. 101 as claiming the same invention as that of claim 2 of prior U.S. Patent No. 6,316,484. This is a double patenting rejection.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, and 61 are rejected under 35 U.S.C. 102(b) as being anticipated by **Sato et. al.** (EP 469,901). On pages 17 and 19, Sato et. al. discloses compounds # 56 & 81 which are embraced by the claimed formula (I) with the following substituents:

- i. Y is S(O)₂;
- ii. Z is -NR¹R²;

Art Unit: 1624


- iii. Either R^1 or R^2 is hydrogen, and the other is a substituted aryl-(C1-C4)heteroalkyl.

Said compounds inhibit platelet aggregation, thus their pharmaceutical compositions read on the claimed pharmaceutical composition as well. Note, the proviso in claim 61 has not adequately excluded the above compounds.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tamthom N. Truong whose telephone number is 703-305-4485. The examiner can normally be reached on M-F (9:30-5:00) & every other Saturday and/or Sunday (starting from 3-15-03).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund Shah can be reached on 703-308-4716. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4556 for regular communications and 703-308-4556 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.


Tamthom N. Truong
Examiner
Art Unit 1624

March 8, 2003